Hovsepian v. Apple, Inc.
Doc. 298 Att. 2

EXHIBIT I

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IN THE UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re: Acacia Media Technologies Corp.	NO. C 05-01114
______________________________________/	**SIXTH CLAIM CONSTRUCTION ORDER**

I. INTRODUCTION

The Court has issued a series of Orders construing the words and phrases of the patents-in-suit. In an Order dated October 19, 2007,[1] the Court requested further briefing with respect to the construction of the phrases "transmission system" and "receiving system" in Claims 19, 41 and their dependent claims[2] in the '992 Patent. Based on the papers submitted to date, the Court issues this Sixth Claim Construction Order.

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[1] (See Order Re: Motions for Reconsideration of Claim Construction; Fifth Claim Construction Order, Docket Item No. 259.)

[2] In the remainder of this Order, unless otherwise stated, the Court will refer to the independent and dependent claims being construed (Independent Claim 19 and Dependent Claims 20, 21, 22; and Independent Claim 41 and Dependent Claims 42, 43, 44, 45, and 46) collectively as, "the subject claims," or as, "Claims 19 and 41."

II. DISCUSSION

Claim 19 of the '992 Patent provides:[3]

A distribution method responsive to requests from a user identifying items in **a transmission system containing information** to be sent **from the transmission system** to **receiving systems** at remote locations, the method comprising the steps of:

> storing, **in the transmission system**, information from items in a compressed data form, the information including an identification code and being placed into ordered data blocks;
>
> sending a request, by the user **to the transmission system**, for at least a part of the stored information to be transmitted to one of the receiving systems at one of the remote location selected by the user;
>
> sending at least a portion of the stored information **from the transmission system** to the receiving system at the selected remote location;
>
> receiving the sent information by the **receiving system** at the selected remote location;
>
> storing a complete copy of the received information in the **receiving system** at the selected remote location; and
>
> playing back the stored copy of the information **using the receiving system** at the selected remote location at a time requested by the user.

Claim 41 of the '992 Patent provides:

A method of transmitting information to remote locations, the transmission method comprising the steps, **performed by a transmission system**, of:

> storing items having information in a source material library;
>
> retrieving the information in the items from the source material library;
>
> assigning a unique identification code to the retrieved information;
>
> placing the retrieved information into a predetermined format as formatted data;
>
> placing the formatted data into a sequence of addressable data blocks;
>
> compressing the formatted and sequenced data blocks;
>
> storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code; and
>
> sending at least a portion of the file to one of the remote locations.

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[3] Unless otherwise indicated, all bold typeface is added by the Court to emphasize the terms and phrases under consideration.

The Preambles and Steps of Claims 19 and 41 require that a step of the process be performed on, with or by[4] a "transmission system" and a "receiving system." Thus, performance on, with or by a "transmission system" and a "receiving system" must be construed because "it breathes life and meaning into the claims," and therefore. forms a limitation in the subject claims. Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc., 381 F.3d 1111, 1118 (Fed. Cir. 2004.) .

The inclusion in a patent of a process that may be performed by a person, but that also is capable of being performed by a machine, is patentable. See Alco Standard Corp. v. Tennessee Valley Authority, 808 F.2d 1490, 1497 (Fed. Cir. 1986). Accordingly, the Court proceeds to construe the phrases with an understanding that a process may be patented with or without claiming use of a device to perform the process.

A. "Transmission System" and "Receiving System" have Specialized Meanings

The claims of the '992 Patent recite as an invention a device called a "transmission system" and a device called a "receiving system." The issue of whether these phrases should be given their ordinary and customary meanings or specialized meanings had been previously addressed by the Court. To be complete, the Court reexamines the issue here.

The standard used by the Court in construing the language of a patent claim is how the language would be understood by a person of ordinary skill in the art reading the patent documents at the time of the invention. See Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed. Cir. 2005). The Court presumes that an ordinarily skilled artisan would understand the words and phrases in a patent claim with their ordinary and customary meanings, unless the inventors demonstrate a clear intent to deviate from the ordinary and customary meanings. Id. In claim construction, the Court presumes that the inventors use the same words and phrases with the same meaning, unless the inventors demonstrate a clear intent to give them different meanings in different contexts. Southwall Techs. v. Cardinal IG Co., 54 F.3d 1570, 1579 (Fed Cir. 1995).

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[4] A process in which a device is "used" to perform a function is different from a process "performed by" a device. In Claims 19 and 41, the "transmission system" is both "used" to perform the process and, itself "performs" some of the steps. Claim 19 recites as a step: "sending a request, by the user to the transmission system. . ." Inherently, in this step, the user is employing or "using" the transmission system as a device to receive the user's request. It is clear from the language of Claims 19 and 41 that the "transmission system" also performs steps to fulfill the purpose of the process.

In the field covering transfer of electronic data, the ordinary and customary meaning attributed to the word "transmission" is the transfer of a signal from one location to another. See INSTITUTE OF ELECTRICAL AND ELECTRONICS ENGINEERING (IEEE) DICTIONARY OF STANDARDS TERMS, 1207 (7th ed. 2000). The ordinary and customary meaning attributed to "receiving" electronic data is receiving data sent from some other location. Id. at 934. The ordinary and customary meaning attributed to the word "system" is a set or an arrangement of things so related or connected as to form a unity or organic whole. See WEBSTER'S NEW TWENTIETH CENTURY DICTIONARY, 1853 (2d ed. 1983). Thus, the ordinary and customary meaning of the phrase "transmission system" is a set or an arrangement of components that operate together to transfer data from one location to another. A similar ordinary and customary meaning exists for "receiving system."

Claims 19 and 41 recite as inventions methods for processing and distributing information performed on, with or by a "transmission system" and a "receiving system." In the device claims, as limitations, the inventors recite that the systems are comprised of configurable and interconnected components, which respond to users.[5] In the course of construing the meaning of words and phrases used in the device claims, the Court came to a determination that the phrases "transmission system" and "receiving system" are phrases coined by the inventors to mean the interconnected, configurable, user-responsive, assemblage of components which the inventors called their

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[5] Every part of the specification clearly states an intent by the inventors that the "transmission system" and the "receiving system" process, store, send and receive the information specifically in response to "users." In both the "Summary of the Invention" and the "Description," the inventors clearly state that "transmission system" and "receiving system" mean specialized systems in which information is processed, stored and transmitted, and received in special ways so that it is responsive to requests made to the systems by individual users.

"invention." By using the word "comprising" with respect to the components, the Court has construed essential components of each device claim.[6]

Thus, the issue becomes whether the phrases "transmission system" and "receiving system" as used in the subject claims should be construed to mean the same interconnected, configurable, user-responsive assemblage of components disclosed in the specification, or whether, because a claim that does not disclose steps which use or must be performed by a particular component, the "systems" in the subject claims should be defined as composed of only those components which are essential to perform the steps in each process. The Court proceeds to examine these considerations.

B. "Transmission System" and "Receiving System" as Assemblage of Components

In making a determination of what the inventors meant by "transmission system" and "receiving system," in the subject claims, the Court has been asked to give particular consideration to the fact that elsewhere in the specification, when referring to "transmission system of the present invention" or "receiving system of the present invention," the inventors refer to a specific assemblage of components:

> FIGS. 1a-1g are high level block diagrams showing different configurations of the transmission and receiving system of the present invention.

('992 Patent, Col. 3:50-60.) Likewise, throughout the written description and drawings, the inventors describe the assemblage of components labeled "transmission system 100" as the "transmission system," and they refer to the assemblage of components labeled "receiving system 200" as the "receiving system."

The Court exercises great care before construing claim language so as to limit claim scope to a device disclosed in the written description. While claims "must be read in view of the specification, of which they are a part[,] . . . it is improper to read a limitation from the specification into the claims." Liebel-Flarsheim Co. v. Medrad, Inc., 358 F.3d 898, 904 (Fed. Cir. 2004). "Accordingly, particular embodiments appearing in the written description will not be used to limit claim language . . . unless the patentee has demonstrated a clear intention to limit the claim scope using 'words or expressions of manifest exclusion or restriction.'" Innova/Pure Water, 381 F.3d at 1117 (citations omitted). Thus, the fact that specific assemblage of components are called the "transmission system" and the "receiving system" in the specification is not dispositive of whether the inventors meant to limit the claim language to those assemblages.[7]

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[6] In construing the claims which recite a system "comprising" enumerated components, the Court construes the claim as open ended, i.e., it permits additional components which are not required by the claim. Power Mosfet Tech., L.L.C v. Siements AG, 378 F.3d 1396, 1409 (Fed. Cir. 2004). Thus, the fact that the inventors claim a "transmission system" or a "receiving system," comprising less than all of the components of the "transmission system" or "receiving system" as defined in the specification is not evidence that the inventors are using the phrases to refer to different systems. The device claim is construed to mean that the disclosed components are essential.

1. A person of skill in the art would understand from explicit statements in the specification that the inventors define "transmission system" and "receiving system" as the configurable assemblage of components labeled "100" and "200."

The purpose of the specification is to teach and enable those of skill in the art to make and use the invention and to provide a best mode for doing so. Thus, the Court's focus is on determining how a person of ordinary skill in the art would understand the relationship between a device called by a particular name in claim language and the device called by that same name in the written description and drawings.

A person of skill would understand that, in some instances, the inventors are explicitly setting out a specific example of the invention to teach how to make and use the invention, and that, in other instances, the inventors "instead intend[] for the claims and the embodiments in the specification to be strictly coextensive." See Phillips,415 F.3d at1323-1324. In this case,

[7] Although the inventors refer to the systems described in Figures 2a, 2b and 6, and the associated written description as "preferred embodiments," there are no other embodiments described in the specification. The Court draws a distinction between an alternative embodiment and alternative processing paths within an embodiment. In other words, both the "transmission system" and the "receiving system" allow alternative processing paths within the disclosed embodiment. For example, the "transmission system" is disclosed as composed of a processing pathway which is different for processing audio information than the pathway for processing video information. Similarly, the interconnections between the components allow information to by-pass some components if the information meets certain system parameters. However, all of these alternative processing pathways are present in the single embodiment of the "transmission system" and "receiving system;" they do not constitute an alternative embodiment of a "transmission system" or a "receiving system." Rather, these intrinsic alternative pathways are pathways in a single embodiment.

throughout the specification, the inventors repeatedly refer to what they label and describe as "transmission system 100" and "receiving system 200" as "the present invention." For example, in one instance the specification discloses as follows:

> FIGS. 1a-1g are high level block diagrams showing different configurations of the transmission and receiving system of the present invention.

('992 Patent, Col. 50-52.) Based on the language in the specification, the Court finds that a person of ordinary skill in the art would understand that the inventors intended the phrases "transmission system" and "receiving system" as used in the subject claims to mean the specific assemblage of components which they describe in the specification.

Before adopting a final construction, the Court considers the effect of language by the inventors that components are "preferably included."

2. The use of the word "preferably included" does not change the Court's conclusion that by the phrases "transmission system" and "receiving system," the inventors mean a specific assemblage of components.

Inherent in any patentable "system" is the existence of components which operate together for a claimed purpose. The components of "transmission system 100" are shown in a block diagram labeled "FIG. 2a" and "FIG. 2b"[8] and the components of "receiving system 200" are shown in a block diagram labeled "FIG. 6." ('992 Patent, Col. 17:67-18:1.)

On the block diagrams and in the written description, the components are described with varying levels of detail. Some of the names of the components are coined by the inventors, others are given functional names. In the specification, the inventors refer to some components as "preferably" included. The following statements in the written description are references to components which are "preferably" included:

> As shown in FIG. 2a, the source material library means included in transmission system 100 **preferably includes a source material library 111**.
>
> * * *
>
> The transmission system 100 of the present invention also **preferably includes conversion means 113** for placing the items from source material library 111 into a predetermined format as formatted data.
>
> * * *

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[8] FIGS. 1a, 1b, 1d, 1e, 1f, and 1g each show transmission system 100, described in more detail below with respect to FIGS. 2a and 2b. ('992 Patent, Col. 3:52-54.)

> The transmission system 100 of the present invention also **preferably includes ordering means** for placing the formatted information into a sequence of addressable data blocks.
>
> * *
>
> The transmission system 100 of the present invention also **preferably includes data compression means** for compressing the formatted and sequenced data.
>
> * * *
>
> The transmission system 100 of the present invention may also **preferably include library access/interface means** for receiving transmission requests to transmit items and for retrieving formatted data blocks stored in the compressed data library 118 corresponding to the requests from users.
>
> * * *
>
> The transmission system 100 of the present invention **preferably further includes transmitter means 122**, coupled to the compressed data library 118, for sending at least a portion of a specific file to at least one remote location.
>
> * * *
>
> FIG. 6 illustrates a block diagram of a **preferred implementation** of the **reception system 200** according to the present invention. The reception system 200 is responsive to user requests for information stored in source material library 111. **The reception system 200 includes transceiver 201** which receives the audio and/or video information transmitted by transmitter 122 of the transmission system 100. The transceiver 201 automatically receives the information from the transmitter 122 as compressed formatted data blocks.
>
> **The transceiver 201 is preferably connected to receiver format converter 202.** The receiver format converter 202 converts the compressed formatted data blocks into a format suitable for playback by the user in real time.

Other components are essential in that the inventors state that the components "must be" included. For example, with respect to "compressed data storage means 118" the inventors state in the specification:

> Prior to being made accessible to a user of the transmission and receiving system of the present invention, the item **must be stored in a least one compressed data library 118**, and given a unique identification code by identification encoder 112.

('992 Patent, Col. 6:35-39.) However, elsewhere in the specification the inventors state that "compressed data library 118" is "preferably" included in the system:

> After the data is processed into a file by the compressed data storage means 117, it is preferably stored in a compressed data library 118.

('992 Patent, Col. 10:36-39.) Thus, a person of ordinary skill in the art reading the patent documents would understand that the phrase "preferably stored in a compressed data library 118" is used to refer to a component which is actually essential.

It is clear that essential components and optional components can be determined from the specification. For example, a person of ordinary skill in the art would understand from the written description and Figure 2a that "identification encoding process 112" is an essential component of "transmission system 100." The inventors specify that the functions of the identification encoding process "must be" performed by "identification encoder 112." Further, in the block diagram of the system, the inventors show no alternative path for the information to follow within "transmission system 100," except through "identification encoding process 112."

> Prior to being made accessible to a user of the transmission and receiving system of the present invention, the item **must be** stored in at least one compressed data library 118, and **given a unique identification code by identification encoder 112.** Storage encoding, performed by identification encoder 112, aside form giving the item a unique identification code, optionally involves logging details about the item, called program notes, and assigning the item a popularity code. Storage encoding may be performed just prior to conversion of the item for transmission to reception system 200, at any time after starting the conversion process, or after storing the item in the compressed data library 118.

('992 Patent, Col. 6:35-46.)

However, there are three interconnecting lines from "identification encoding process 112" to the other components in the system. One of these lines skips a series of components and connects to "compressed data formatting section 117 prime." Thus, the skipped components are made "nonessential" if the claim does not require their processes.[9]

Two lines from component 112 lead to "converter 113."[10] Within "converter 113" one of the lines is connected to "analog input receiver 127." The other line is connected to "digital input receiver 124." These lines are intended by the inventors to define the interconnection as being with one of two alternative receivers or with both. To clarify that the lines mean the components are optional, the inventors expressly state in the written description that one of the receivers could be left out of the transmission system altogether if the information being processed is **digital only**:

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[9] With respect to "transmission system 100," a person of skill in the art would understand from the patent documents that the five components labeled "transceiver 122" shown on Figure 2b are optional components. Similarly, the components labeled "output format conversion 206" in the block diagram for "receiving system 200" are optional components. However, having at least one of these components is essential.

[10] On Figure 2a, the component labeled "113" is not given a name. However, in the written description it is called "converter 113." ('992 Patent, Col. 6:65.)

> The transmission system 100 of the present invention also preferably includes conversion means 113 for placing the items from source material library 111 into a predetermined format as formatted data. In the preferred embodiment, after identification encoding is performed by identification encoder 112, the retrieved information is placed into a predetermined format as formatted data by the converter 113. The items stored in source material library 111 and encoded by identification encoder 112 may be in either analog or digital form. Converter 113 therefore includes **analog input receiver 127** and **digital input receiver 124. If items have only one format, only one type of input receiver 124 or 127 is necessary.**

('992 Patent, Col. 6:55-68.) Inherently, if "converter 113" is essential under these circumstances, an input receiver of at least one type is essential.

However, the issue here is not whether "transmission system" or "receiving system" contain essential components or whether the interconnecting lines between components would allow a sub-system to be disclosed as an independently operable system. The issue is what a person of ordinary skill in the art would understand the inventors to mean by the phrases "transmission system" and "receiving system." In other words, although the systems have capabilities which would allow a sub-system to be disclosed as an independently operable device, the issue is whether by using the phrases "transmission system" and "receiving system" in the subject claims, the inventors disclose using the systems or disclose using sub-systems.

3. Although an independently functional sub-system of the "transmission system" and "receiving system" potentially could be disclosed as a device which could be used to perform a process, in the subject claims the inventors did not disclose a sub-system.

Having found that the inventors used "transmission system" and "receiving system" to mean a specialized, configurable, assemblage of components, the Court returns to the issue under consideration: Whether a person of skill in the art reading the patent documents would understand that the phrases "transmission system" or "receiving system," as used in the subject claims, mean a sub-system or whether the phrases mean the configurable assemblage of components so named in the specification. Here, the inventors disclose a configurable assemblage of components which functions under a variety of circumstances. While the disclosed interconnections would allow functional sub-systems to be disclosed, the inventors chose to disclose that the processes were performed on, with or by the "transmission system" and the "receiving system," and not on, with or by a sub-system of either of those systems. Nothing in the claims, including the specification, indicate that the inventors intended to impart to the phrases "transmission system" or "receiving system" any different definition from the definition used elsewhere in the patent documents. Accordingly, the Court finds clear intent on the part of the inventors that the phrases "transmission system" and "receiving system" mean the configurable, interconnected assemblage of components labeled "100" and "200."

In sum, although the steps in a particular method claim might not use all of the capabilities or components of the "systems," the subject claims disclose that the process is performed by, on or with the "transmission system" or "receiving system." Since no other definition of those systems is given, for purposes of claim construction, the Court construes the claims to require those systems as defined by the inventors.

C. Construction of "Transmission System" and "Receiving System"

In light of the above analysis, the Court construes the phrases as follows:

As used in Independent Claims 19 and 41 and their respective Dependent Claims of the '992 Patent, **"transmission system"** means: **the configurable, interconnected, assemblage of components labeled and described in the specification as "transmission system 100," a detailed block diagram of which is shown on Figures 2a and 2b.**

As used in Independent Claims 19 and 41 and their respective Dependent Claims of the '992 Patent, **"receiving system"** means: **the configurable, interconnected, assemblage of components labeled and described in the specification as "receiving system 200," a detailed block diagram of which is shown on Figure 6.**

III. CONCLUSION

The Court considers that it has now construed all Claims submitted to the Court. The Court leaves for later, any consideration of whether an allegedly infringing system, which contains some but not all of the components of "transmission system 100" or "receiving system 200," nevertheless infringes the subject claims.

The parties shall appear for a Case Management Conference on **March 7, 2008 at 10 A.M.** The parties shall meet and confer and file a Joint Case Management Statement on or before **February 29, 2008.** The statement shall include a discovery plan and a proposed schedule for dispositive motions.

Dated: February 13, 2008

JAMES WARE
United States District Judge

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Dated: February 13, 2008

Richard W. Wieking, Clerk

By: /s/ JW Chambers
Elizabeth Garcia
Courtroom Deputy

EXHIBIT J

COUNSEL LISTED ON SIGNATURE PAGES

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re

ACACIA MEDIA TECHNOLOGIES CORPORATION

Case No. 05-CV-1114 JW

PARTIES' STIPULATED DEFINITIONS FOR CLAIM TERMS FROM THE '863 AND '720 PATENTS

Date: September 7-8, 2006
Time: 9:00 a.m.
Courtroom: 8, 4th Floor
Judge: Hon. James Ware

The parties[1] to this action hereby submit the following constructions for claim terms of U.S. Patents 5,550,863 and 6,002,720 that are not disputed:[2]

1. The phrase "a plurality of subscriber (selectable) receiving stations coupled to the local distribution system"[3] in Claims 14 and 17 of the '863 patent and Claims 8 and 11 of the '720 patent means that two or more "subscriber (selectable) receiving stations"[4] must be "coupled to" the local distribution system.

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[1] For the purposes of the issues involving the '863 and '720 patents, the parties are the Round 2 Defendants, who are the Cable and Satellite defendants whom Acacia sued in the first two rounds of complaints, and the Round 3 defendants, who are two of the cable company defendants whom Acacia sued in New York in the third round of complaints: Time Warner Cable Inc. and CSC Holdings, Inc.. The Round 2 Defendants are: Comcast Cable Communications, LLC; The DIRECTV Group, Inc.; EchoStar Satellite LLC; EchoStar Technologies Corp.; Charter Communications, Inc.; Armstrong Group; Block Communications, Inc.; East Cleveland Cable TV and Communications LLC; Wide Open West Ohio LLC; Massillon Cable TV, Inc.; Mid-Continent Media, Inc.; US Cable Holdings LP; Savage Communications, Inc.; Sjoberg's Cablevision, Inc.; Loretel Cablevision; Arvig Communications Systems; Cannon Valley Communications, Inc.; NPG Cable, Inc.; Cable One, Inc.; Mediacom Communications Corp.; Bresnan Communications; Cequel III Communications I, LLC (dba Cebridge Connections); Coxcom, Inc.; Hospitality Network, Inc., and Cable America, Inc. Although Defendants Insight Communications, Inc. and Bresnan Communications were sued in Round 3, they are joining the Rounds 1 and 2 Defendants' proposed constructions. Acacia is not asserting the '863 and '720 patents against the Round 1 defendants (the Internet defendants), which includes New Destiny Internet Group LLC; Audio Communications, Inc.; VS Media Inc.; Ademia Multimedia LLC; Adult Entertainment Broadcast Network; Cyber Trend Inc.; Lightspeed Media Group, Inc.; Adult Revenue Services; Innovative Ideas International; Game Link Inc.; Club Jenna Inc.; Global AVS Inc.; ACMP LLC; Cybernet Ventures Inc.; National A-1 Advertising Inc.; and AEBN, Inc; International Web Innovations, Inc., Offendale Commercial BV, AskCS.com. Accordingly, the Internet defendants have not participated in the preparation of this chart and have no position on the construction of any claim terms that pertain only to '863 and '720 patents. Likewise, the Rounds 2 and 3 Cable Defendants take no position on the construction of any claim terms that pertain only to the '720 patent since that patent has not been asserted against those parties.

[2] Each defendant stipulates to the construction of terms or limitations which are recited in claims asserted against it. Acacia and each defendant reserves the right to seek construction of additional claim terms, or propose a new construction of terms and limitations listed herein, should Acacia be permitted to assert additional claims against each defendant in the future.

[3] Claims 14 and 17 of the '863 patent, and the construction thereof, use the phrase "subscriber receiving stations." Claims 8 and 11 of the '720 patent, and the construction thereof, use the phrase "subscriber selectable receiving stations."

[4] The Round 2 Defendants contend that the phrase "subscriber receiving stations" is otherwise indefinite.

2. The term “remote from,” as used in the ‘863 and ‘720 patents, means “distant in space from.”

3. The term “non-real time rate” means a rate (described in terms of time) that is different than the actual rate (described in terms of time) during which a particular item (e.g., video or audio) is listened to or viewed.

4. The term “real time rate” is a rate (described in terms of time) that is the actual rate (described in terms of time) during which a particular item (e.g., video or audio) is listened to or viewed.

5. In Claim 14 of the ‘863 patent, the “transmitting step” includes, but is not limited to, the steps of:

   (a) “inputting an item having information into the transmission system;”

   (b) “assigning a unique identification code to the item having information;”

   (c) “formatting the item having information as a sequence of addressable data blocks;”

   (d) “compressing the formatted and sequenced data blocks;”

   (e) “storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code ;” and

   (f) “sending at least a portion of the file at the non-real time rate to the local distribution system.”

These steps are part of the step of “transmitting compressed, digitized data representing a complete copy . . . from a central processing location.” While the parties disagree on the meaning of “central processing location,”[5] the parties agree that the transmission system is located at the central processing location and that the transmitting steps, including steps (a) - (f) listed above, are performed by the transmission system.

[5] The Round 2 Defendants contend that the phrase “central processing location” is indefinite.

6. In Claim 17 of the ‘863 patent, the “formatting step” includes, but is not limited to, the steps of:

(a) “inputting an item having information into the transmission system;”

(b) “assigning a unique identification code to the item having information;”

(c) “formatting the item having information as a sequence of addressable data blocks;”

(d) “compressing the formatted and sequenced data blocks.”

These steps are part of the step of “formatting items of audio/video information as compressed digitized data at a central processing location.” While the parties disagree on the meaning of “central processing location,”[6] the parties agree that the transmission system is located at the central processing location and that the formatting steps, including steps (a) - (d) listed above, are performed by the transmission system.

7. While the parties disagree on the construction of “local distribution system,” in Claims 14 and 17 of the ‘863 patent and Claims 8 and 11 of the ‘720 patent, the parties agree that the local distribution system is at a location that is distant in space from the location of the central processing location,[7] and is distant in space from the locations of the plurality of subscriber receiving stations.[8]

8. The “means for receiving” in Claim 4 in the ‘720 patent recites the function of “receiving compressed, digitized data representing at least one item of audio/video information at a non-real time rate.” The specification discloses that this function is performed by transceiver 201. Therefore, the term “means for receiving” in claim 4 of the ‘720 patent shall be construed as transceiver 201, and its equivalents.

[6] The Round 2 Defendants contend that the phrase “central processing location” is indefinite.

[7] The Round 2 Defendants contend that the phrase “central processing location” is otherwise indefinite.

[8] The Round 2 Defendants contend that the phrase “subscriber receiving stations” is otherwise indefinite.

9. The "means for storing" in Claim 4 of the '720 patent recites the function of "storing a complete copy of the received compressed, digitized data." The specification discloses that this function is performed by storage 203 and 200c. Therefore, the term "means for storing" in claim 4 of the '720 patent shall be construed as storage 203 or 200c, and their equivalents.

10. The "compression means" in Claim 7 of the '720 patent recites the function of "compressing the formatted data." The specification discloses that this function is performed by compressor 116. Therefore, the term "compression means" in claim 7 of the '720 patent shall be construed as compressor 116, and its equivalents.

11. The "receiving means" in Claims 8 and 11 of the '720 patent recite the function of "receiving compressed, digitized data representing at least one item of audio/video information at a non-real time rate." The specification discloses that this function is performed by transceiver 201. Therefore, the term "receiving means" in claims 8 and 11 of the '720 patent shall be construed as transceiver 201, and its equivalents.

12. The "storing means" in Claims 8 and 11 of the '720 patent recite the function of "storing a complete copy of the received compressed, digitized data." The specification discloses that this function is performed by storage 203 and 200c. Therefore, the term "storing means" in claims 8 and 11 of the '720 patent shall be construed as storage 203 or 200c, and their equivalents.

13. The parties disagree as to whether the steps of Claims 14 and 17 of the '863 patent and Claims 8 and 11 of the '720 patent begin and occur only after a prior step or steps have been completed. This is the same issue that was argued to the Court during the last round of *Markman* briefing with respect to the steps of method claims in the '992 and '275 patents.

14. The parties disagree as to whether the "compressing the formatted and sequenced data blocks" step of Claims 14 and 17 of the '863 patent requires that the sequence of the formatted data blocks be maintained by the compression process. This is the same issue that was argued to the Court during the last round of *Markman* briefing with respect to the

"compressing the formatted and sequenced data blocks" step of claim 41 of the '992 patent.

15. The steps of Claim 14 of the '863 patent must be performed in the following order:

1) "transmitting compressed, digitized data representing a complete copy . . . from a central processing location";
2) "receiving the transmitted compressed, digitized data . . .";
3) "storing the received compressed digitized data representing the complete copy . . .";
4) "decompressing the compressed, digitized data . . ."
5) "in response to the stored compressed, digitized data, transmitting a representation . . ."

The steps which follow the clause "wherein the transmitting step comprises" are performed as part of the step of "transmitting compressed, digitized data ...", and must be performed in the following sequential order with respect to each other:

1) "inputting an item . . ."
2) "assigning a unique identification code . . ."
3) "formatting the item . . ."
4) "compressing . . ."
5) "storing, as a file . . ." and
6) "sending at least a portion . . ."

16. The steps of Claim 17 of the '863 patent must be performed in the following order:

1) "formatting items . . . at a central processing location."
2) "transmitting . . . from the central processing location";
3) "receiving the transmitted compressed, digitized data. . .";
4) "storing the received compressed, digitized data representing the complete copy. . ."; and
5) "using the stored compressed, digitized data to transmit . . ."

The steps which follow the clause "wherein the formatting step comprises" are performed as part of the step of "formatting items ... at a central processing location" and must be performed in the following sequential order with respect to each other:

1) "inputting an item. . ."

2) "assigning a unique identification code. . ."

3) "formatting the item . . ." and

4) "compressing . . ."

17. The steps of Claim 8 of the '720 patent must be performed in the following order:

1. "transmitting compressed, digitized data . . .";

2. "receiving, into a receiving means, . . .";

3. "storing, in a storing means, . . ."; and

4. ". . . transmitting, using a transmitting means, . . ."

18. The steps of Claim 11 of the '720 patent must be performed in the following order:

1. "formatting items of audio/visual information. . . ."

2. "transmitting compressed, digitized data . . .";

3. "receiving, into a receiving means, . . .";

4. "storing, in a storing means, . . ."; and

5. "using the stored compressed, digitized data to transmit, using a transmitting means, . . ."

19. The term "sending" in claim 14 of the '863 patent and Claim 7 of the '720 patent, as well as in claims 2 and 5 of the '275 patent, means "transmitting electronically or optically."[9]

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[6] The stipulated construction of "sending" in claims 2 and 5 of the '275 patent was inadvertently omitted from the stipulation filed on April 17, 2006.

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UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re

ACACIA MEDIA TECHNOLOGIES CORPORATION

Case No. 05 CV 01114 JW

PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF ITS MOTION FOR RECONSIDERATION OF CERTAIN CLAIM CONSTRUCTION TERMS CONSTRUED BY THE COURT IN ITS THIRD CLAIM CONSTRUCTION ORDER AND ITS FOURTH CLAIM CONSTRUCTION ORDER

DATE: August 17, 2007
TIME: 9:00 a.m.
CTRM: Hon. James Ware

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the claims beyond their support in the specification. *See, Wang Laboratories, Inc. v. America Online, Inc.*, 197 F.3d 1377, 1383 (Fed. Cir. 1999) (holding that the claim term "frame" is limited to a "character-based protocol," because this was the only embodiment disclosed in the specification: "The usage 'preferred' does not of itself broaden the claims beyond their support in the specification.… The only embodiment disclosed in the '669 patent specification is the character-based protocol, and the claims were correctly interpreted as limited thereto.") Second, the word "preferred," when used in a patent specification, has a special meaning that has nothing to do with indicating that other embodiments are possible or are contemplated. The word "preferred" when used in a patent specification refers to the "best mode," which is the statutory requirement pursuant to 35 U.S.C. § 112, ¶1 that the patentee disclose the best mode known to him or her of carrying out the invention. A patentee, who has just one embodiment for his or her invention, can refer to that embodiment as being the "preferred" embodiment (to show compliance with § 112), without the word "preferred" meaning that other embodiments are possible or contemplated. Defendants cannot demonstrate that the specification supports any other addressing scheme, other than time encoding, because there is no other addressing scheme disclosed or suggested in the specification.

C. The Court's Construction Of The Term "Storing" In The Phrase "Storing Items Having Information In A Source Material Library" Is Erroneous

In its 3rd CCO, the Court revisited its construction of the phrase "storing items having information in a source material library." The Court separately addressed and construed each of the constituent terms of this phrase. Acacia only seeks reconsideration of the Court's construction of the term "storing" in this phrase, which the Court construed as meaning "placing" or "putting." (3rd CCO, at 30:11-25). To be consistent with the patent specification, the term "storing" in this phrase should mean "retaining."[24]

1. The Term "Storing" Has Multiple Ordinary Meanings

In construing the term "storing," the Court did not state whether it considered the definitions

---

[24] In an earlier brief, Acacia used the word "maintaining" which is a perfect synonym for the word "retaining" when used in the phrase "retaining items having information in a source material library."

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of the term "store" from the IEEE Dictionary. In the IEEE Dictionary, the term "store" is defined as having multiple meanings:

> 1. To place data into a device [into which data can be placed, in which they can be retained, and from which they can be retrieved];
>
> 2. To retain data in a device [into which data can be placed, in which they can be retained, and from which they can be retrieved]; and
>
> 3. To place or retain data in a storage device. (Block Decl., Exh. 3) (See also, (Weiss Decl., at ¶¶ 17-19).

From the Court's 3rd CCO, we do not know whether the Court considered one of the ordinary meanings of "store" – "to retain data."

2. The Court's Requirement That Every Step In A Method Claim Be A So-Called Manipulative Step Is Erroneous

In its 3rd CCO, the Court stated that "a step in a method claim must be a manipulative step or act." (3rd CCO, at 30:13; *see also*, 25:15-16). Although this statement appears to be a statement of law, the Court cites to no statute or case authority for this being a legal requirement of a method step. Acacia is not aware of any statute or Federal Circuit case which has ever set forth the legal requirement that every step in method claim be a "manipulative step or act."

In a search of the relevant phrase, Acacia found a single district court case, *Daiichi Pharm. Co. v. Apotex, Inc.*, 441 F.Supp.2d 672, 677 (D. N.J. 2006) which used the phrase "manipulative step," and it did so in a footnote. That footnote in its entirety read:

> As its title indicates, the '741 patent is a "method" patent, as compared to a machine, composition, or manufacture patent. One treatise explains: "the 'elements' of a method claim, instead of being structural parts, are, and must be, acts or manipulative steps that are performed upon an article, workpiece, or chemical substance. It is the transformation or reduction of the article, workpiece, or chemical substance to a different state or thing that is the essence of a method claim – and the key to its patentability."

Id. fn. 9 If this quote is the source of this Court's statement of the law that "a step in a method claim must be a manipulative step or act," the Court misreads the legal importance of the quote. It nowhere says in that quote that each and every step in a method must be a "manipulative" step, only that method claims must include manipulative steps sufficient to transform or reduce "an article,

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workpiece, or chemical substance to a different state or thing." A method claim for baked bread is a good example. The manipulative steps of (1) adding ingredients, (2) placing ingredients in a buttered baking pan and (3) placing the buttered pan including the ingredients in a preheated oven at 350° would precede the "non-manipulative" step of leaving (retaining) that pan in the oven for 45 minutes before the final manipulative step of removing the pan from the oven. The inclusion of that non-manipulative step in the method does not cause the method claim to be invalid or ineffectual, as this Court's legal pronouncement would require. In fact, it is central to the method being practiced, otherwise you would burn the bread.

The same is true in the method claims in this case. Claim 41 claims a method for transmitting information. The first step of the method is "storing items having information in a source material library" and the second step of the method is "retrieving the information in the items from the source material library." The steps thereafter describe the transmission of the items. Thus, for the second step of retrieving to take place, the items having information must first be ***retained*** in the source material library. The steps thereafter describe the transmission of the items. There is no question that Claim 41 contains so-called manipulative steps, even when the word "storing" is construed to mean "retaining," and there is no question that Claim 1 describes a method that achieves "a different state," i.e., the transmission of items having information. ('992 patent, 5:66-6:2).

3. The Court Should Construe "Storing" Consistent With The Description In The Specification

The Federal Circuit instructs that claims are to be construed ***consistent*** with the specification.[25] Construing "storing" to mean "placing" is, however, inconsistent with the specification.

Here, the specification describes the source material library as retaining (not placing) the items, and thus the term "storing" should be construed to mean "retaining." The specification describes the purpose of the "source material library" as being "storage." ('992 patent, 5:66 – 6:2).

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[25] *See, e.g., Phillips*, 415 F.3d at 1314-1316; *Merck*, 347 F.3d at 1371.

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In fact, when describing and depicting an embodiment of the distribution method (claim 41 is a method claim), the patentees state that the first step of the method "involves retrieving the information for selected items in the source material library 111" ('992 patent, 18:53-55). The patentees depicted this method in the flow chart of Figure 7, in which the first step shown is "retrieve information for selected items." In other words, according to the patent specification, the method does not begin with the placement of any item into the source material library, because, for this particular claim, it is assumed that the items having information are already stored in the source material library and thus are accessible for retrieval. The Court itself recognized this when it stated that the specification is "silent as to any capabilities of the source material library to do any function other than to hold items having information."[26] (3rd CCO, at 30:11-13).

4. The Court Should Construe The Claim Terms "Storing" and "Inputting" Differently

In its 4th CCO, the Court construed the phrase "inputting an item having information into the transmission system" of claim 14 of the '863 patent (which is a continuation patent claiming priority from the '992 patent) to mean "putting physical items containing audio information or video information or both into the transmission system." (4th CCO, at 11-12). The Court's construction for the term "inputting" in this related patent is the same as that for "storing" in the '992 patent.

The Court should not give different claim terms in related patents the same construction, because there is a presumption that different claim terms have different meanings.[27] Here, the term "inputting" means "putting in;" it has no other meaning. "Storing," on the other hand, has another meaning – "retaining" – which is consistent with the specification. Therefore, the Court should give

---

[26] The fact that the specification only describes the source material library as retaining data is not fatal to the validity of the '992 patent. Persons of ordinary skill in the art would have inferred from the specification that the items having information (construed to be physical items) were first placed into the source material (construed to be a collection of original sources of information) before they could be stored there. These persons would also have known how such physical items are placed into a collection of such items, without the need for the patentees to have described in detail how this would have occurred.

[27] *See, CAE Screenplates, Inc. v. Heinrich Fiedler GMBH & Co.*, 224 F.3d 1308, 1317 (Fed. Cir. 2000) ("In the absence of evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings.").

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the term "storing" a meaning different than that given to the term "inputting." This is an additional reason why the Court should construe "storing" in the phrase "storing items having information in a source material library" to mean "retaining physical items containing audio information or video information or both in a collection of original sources of information."

IV. CONCLUSION

For all these reasons and authorities, Acacia's Motion for Reconsideration should be granted.

DATED: May 18, 2007

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In re ACACIA MEDIA TECHNOLOGIES CORPORATION	)	Case No. 05 CV 01114 JW **DECLARATION OF S. MERRILL WEISS IN SUPPORT OF PLAINTIFF ACACIA MEDIA TECHNOLOGIES CORPORATION'S MOTION FOR RECONSIDERATION OF CERTAIN CLAIM CONSTRUCTION TERMS CONSTRUED BY THE COURT IN ITS THIRD CLAIM CONSTRUCTION ORDER AND ITS FOURTH CLAIM CONSTRUCTION ORDER** DATE: August 17, 2007 TIME: 9:00 a.m. CTRM: Hon. James Ware

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in the contexts of a variety of system types. As evidenced by the repeated use of the term "receiving system" in the prior art (as described in the paragraph below), a person of ordinary skill in the art in 1991 would have understood that the term "receiving system" was the inverse of the term "transmission system" and that it would have meant "an assembly of elements capable of functioning together to receive transmitted signal waves."

16. The term "receiving system" was used many times in patents prior to 1991. A search of the US Patent and Trademark Office database indicates that there were 78 patents issued in the 15 years prior to 1991 (i.e, from January 1, 1976 through December 31, 1990) that contained the term "receiving system" in their titles. During the same period, there were 1,707 patents issued that contained the phrase in their specifications. Not all of the patents containing the words "receiving system" in their titles or specifications relate to a video and audio receiving system, but a search of patents issued during the period that contained the phrase "receiving system" plus the words "video," "audio," or "television" in their specifications located 638 such patents.

VII. Storing

17. I have been asked what the word "storing" would have meant to one of ordinary skill in the field relevant to the patent family in 1991. The concept of storing has two aspects. One is the aspect of placing or putting objects or information into a storage container. The other aspect is the act of retaining, holding, or maintaining objects or information that already exist in a storage container.

18. There are many ways in which objects or information can be put into a storage container. In the context of the patents at issue, the storage ultimately will be in digital data form, with provisions made in certain parts of the system for storing a variety of materials in other forms. The requirements for placing any specific contents into storage will depend upon the types of content items and the configuration of the storage system for accommodating that particular type of content. For example, the content of a motion picture could be stored in silver halide of varying

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density on a celluloid strip on a film reel, in an analog or digital tape recording of an electronic representation of the image and sound that constitute the motion picture content, or as a digital data file containing another type of electronic representation of the image and sound that constitute the content of the motion picture. The data file, in turn, could be contained in anything from volatile random access memory (RAM) to rotating magnetic storage devices (e.g., hard drives) to rotating optical media (e.g., compact disks – CDs). Once stored, the content could be relatively easily moved from one form of representation to another in order best to meet the needs for preservation and utilization of the content. When in digital form, the content also may be stored in a compressed or an uncompressed manner.

19. Once content is entered into a storage system, the other aspect of "storing" comes into play: The content must be retained and maintained so that it will be available for use when needed. It is well known (and was in 1991) that keeping content in storage requires active maintenance in order to avoid deterioration of the material. For film and tape, such maintenance often includes retaining the media in an environment having controlled temperature and humidity – sometimes with robotic machinery to load and unload the media for reading when necessary and sometimes involving human loading and unloading of the media to and from appropriate transport devices when needed. When the content is stored in volatile memory, the storage maintenance process may involve keeping power on the memory devices and continually refreshing them through a combination of pulses applied to them. When the content is stored on rotating media of all sorts, the maintenance process likely will involve the periodic movement of copies of the content from one medium to another as the medium on which the content is stored reaches end-of-life as an individual unit or when the particular type of medium is no longer supported as a product and is superseded by more modern technology.

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I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct to the best of my knowledge and belief.

Executed this 18th day of May, 2007, at Metuchen, New Jersey.

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